

REMARKS

1. Introduction

In the Office Action mailed February 8, 2006, the Examiner rejected claims 1, 33, 34, 51, 56, and 72 under 35 U.S.C. § 102(e) as being anticipated by Boals et al., U.S. Patent No. 6,108,727 ("Boals").

The Examiner rejected claims 1-5, 9-15, 18, 33, 34, 37-43, 46-60, 63-66, 68, 70, 71, and 74-78 under 35 U.S.C. § 103(a) as being unpatentable over Criss et al., U.S. Pub. No. 2001/0029178 ("Criss") in view of Boals.

The Examiner rejected claims 6, 7, 35, 36, 61, 62, 72, and 73 under 35 U.S.C. § 103(a) as being unpatentable over Criss in view of Boals and in further view of Grewe et al., U.S. Patent No. 5,625,673 ("Grewe").

The Examiner rejected claims 16 and 44 under 35 U.S.C. § 103(a) as being unpatentable over Criss in view of Boals and in further view of Gombrich, U.S. Patent No. 4,916,441 ("Gombrich").

The Examiner rejected claims 17 and 45 under 35 U.S.C. § 103(a) as being unpatentable over Criss in view of Boals and in further view of Shimura, U.S. Patent No. 5,754,624 ("Shimura").

The Examiner rejected claims 19-21, 67, and 69 under 35 U.S.C. § 103(a) as being unpatentable over Criss in view of Boals and in further view of Ausems et al., U.S. Patent No. 6,434,403 ("Ausems").

The Examiner rejected claims 22-25, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Criss in view of Gerszberg, U.S. Patent No. 5,297,192 ("Gerszberg") and Boals.

The Examiner rejected claims 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Criss in view of Gerszberg and Boals and in further view of Grewe.

The Examiner rejected claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Criss in view of Gerszberg and Boals and in further view to Shimura.

The Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Criss in view of Gerszberg and Boals and in further view of Gombrich.

The Examiner indicated that claims 8, 28, 79, and 80 contained allowable subject matter but objected to these claims as being dependent upon rejected base claims.

For the reasons set forth below, Applicants respectfully request reconsideration and allowance of the claims.

2. Statement of Substance of Interview

Applicants thank the Examiner for scheduling the telephonic interview conducted on May 9, 2006. The participants in the interview were Richard A. Machonkin, on behalf of Applicants, and Examiner Keith Ferguson. During the interview, the Boals reference was discussed, with reference to claim 1.

Applicants' representative argued that host 101 in Boals, on which the Examiner relied, is not a server based on (i) the fact that Figure 2 in Boals distinguishes between host 101 and server 108 and (ii) the fact that host 101 communicates with wireless interface device 100 by transmitting "video events" to wireless interface device 100, e.g., as described in col. 13, lines 33-37.

Applicants' representative also argued that the Examiner did not adequately explain what disclosure in Boals supposedly meets the element of "embedded machine language

instructions ... for processing said downstream data to provide at least one electronic file in said memory,” as recited in claim 1. The Examiner cited to col. 6, lines 51-54 of Boals. However, that section simply states that wireless interface device 100 is able to access files residing at host 101; it does not disclose that the files on host 101 are provided by downstream data transmitted by wireless interface device 100. To the contrary, Boals discloses that the data that host 101 receives from wireless interface device 100 are simply “pen events,” e.g., as described in col. 13, lines 25-32.

No agreement was reached during the interview.

3. Response to Claim Rejections

All of the Examiner’s claim rejections rely on Boals. However, the Examiner has misapprehended the disclosure of Boals in at least two ways:

- The Examiner has alleged that host 101 in Boals constitutes a “wireless intelligent network server,” as recited in Applicants’ claims. In fact, Boals makes clear that host 101 is not a server at all.
- The Examiner has assumed that the files on host 101 accessed by wireless interface device 100 are provided by downstream data from wireless interface device 100. In fact, Boals explains that the data that wireless interface device 100 transmits to host 101 are simply “pen events” regarding the position of a stylus.

These two points are described in more detail below. Applicants respectfully submit that when Boals is properly understood, the Examiner’s claim rejections cannot stand.

a. Host 101 in Boals is not a “network server”

The Examiner’s claim rejections are premised on identifying host 101 in Boals as a “wireless intelligent network server.” Applicants respectfully remind the Examiner that the language “network server” was carefully chosen during the interview conducted on September 21, 2004 in order to more clearly define the invention. Moreover, it was agreed during the interview that amending the claims to recite a “wireless intelligent network server” would overcome the prior art of record, and Applicants amended the claims to recite a “network server” in reliance on this agreement. With this background, Applicants respectfully submit that the Examiner cannot ignore the importance of the “network server” language in the claims.

In particular, the Examiner has asserted that element 101 in Boals is a “wireless intelligent network server.” However, Boals does not describe element 101 as a “server” of any kind. Instead, Boals simply describes element 101 as a “remote host computer,” which can be configured as either a stand-alone unit or as part of a local area network (LAN). *See* col. 5, lines 46-50. Because Boals does not state that host 101 is a server, the Examiner’s identification of host 101 as a “wireless intelligent network server” is without basis.

Moreover, Boals makes clear host 101 is not a server. For example, the LAN embodiment shown in Figure 2 of Boals includes both host 101 and server 108. By distinguishing between host 101 and server 108, Figure 2 confirms that host 101 is not a “server.”

That host 101 is not a server is also made clear by how it communicates with wireless interface device 100. Specifically, what wireless interface device 100 receives from host 101 is a video image to be displayed. *See* col. 6, lines 47-48. Thus, when an

application program running on host 101 generates output data, host 101 transmits “video events” to wireless interface device 100. *See* col. 13, lines 33-37. Wireless interface device 100 receives the video events as display commands, and CPU 112 in wireless interface device 100 executes the display commands to update the display. *See* col. 11, lines 51-59.

This description in Boals indicates that host 101 is not acting as a “network server.” A better description of the communication from host 101 to wireless interface device 100 would be to say that host 101 is acting as a video display driver and wireless interface device 100 is acting as a video monitor.

b. Boals does not teach that the files on host 101 originate from wireless interface device 100

The Examiner’s claim rejections are also premised on the misconception that the files on host 101, which wireless interface device 100 are able to access, also originate from wireless interface device 100. For example, claim 1 recites “a set of embedded machine language instructions ... for processing said downstream data to provide at least one electronic file in said memory.”

In rejecting claim 1, the Examiner alleged that this element was inherent in col. 6, lines 51-54 of Boals. However, that section simply refers to wireless interface device 100 being able to *access* “files residing at the host computer 101.” The section does not state that the files on host 101 are *provided* by processing downstream data (i.e., data that is transmitted over a wireless communications channel) from wireless interface device 100. Nor can the Examiner establish this element inherently:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

See MPEP § 2112(IV) (emphasis original).

In this case, the Examiner has not provided any reason why the files on host 101 would ***necessarily*** originate from data transmitted by wireless interface device 100.

Furthermore, the mere possibility is not sufficient to establish inherency:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

See MPEP § 2112(IV) (emphasis original).

In any event, Boals explains that the data that wireless interface device 100 transmits to host 101 are simply “pen events” regarding the position of a stylus. *See* col. 6, lines 38-46, col. 12, lines 14-27. These “pen events” are what host 101 processes as input data. *See* col. 13, lines 25-32. Moreover, Boals explains that this stylus data from wireless interface data 100 is used to ***control*** programs running in host 101. *See* col. 11, lines 51-57. Thus, the data from wireless interface device 100 does not ***provide*** the electronic files stored in host 101.

For at least the foregoing reasons, Applicants respectfully submit that the Examiner’s claim rejections (all of which rely on Boals) are improper and should be withdrawn.

4. **Conclusion**

Applicants submit that the present application is in condition for allowance, and notice to that effect is hereby requested. Should the Examiner feel that further dialog would advance the subject application to issuance, he is invited to telephone the undersigned at any time at (312) 913-0001.

Respectfully submitted,

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